

REMARKS

I. INTRODUCTION

The Final Office Action mailed May 28, 2010, (hereinafter “the Office Action”) has been carefully considered. In light of the following discussion, Applicant respectfully requests favorable reconsideration and allowance of the present application.

II. STATUS OF THE CLAIMS

Claims 34, 36, 37, 39-45, 47-58, 60-70, and 72-75 are pending, with Claims 34 and 70 being independent. By the present Amendment, Claims 34, 43, and 70 are amended. More particularly, those claims are amended to recite various features regarding the sale of the object (e.g., “selling an object”, “seller’s location”, “when the object is being sold”, and “buyer’s location”). Support for those amendments is provided, for example, at page 9, lines 20-22, of the Specification and previously-cancelled Claim 59, wherein the system of the present invention is disclosed as being utilized as a business mechanism for making sales (i.e., selling an object). Based on that disclosure, a person having ordinary skill in the art would readily appreciate that the input means and output means could be placed at a seller’s location and a buyer’s location, respectively. Moreover, a person having ordinary skill in the art would readily appreciate that the transmission would take place “when the object is being sold.” Thus, each of the sales-related amendments finds support in the Specification, as filed, and Applicant respectfully submits that no new matter is added by those amendments.

III. SUMMARY OF THE OFFICE ACTION

The Office Action rejects Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 101 for lack of utility; rejects Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; rejects Claims 70 and 72-75 under 35 U.S.C. § 112, second paragraph, as being indefinite; and rejects Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 102(b) as anticipated by portions from Sternbach et al., "Star Trek The Next Generation Technical Manual" (hereinafter "the Sternbach reference"). For the reasons discussed below, those rejections are respectfully traversed.

IV. CLAIM REJECTIONS

A. Rejection of Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 Under 35 U.S.C. § 101

The Office Action rejects Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 101 for lack of utility. In more detail, the Office Action rejects those claims for lack of utility based on the conclusion that the claimed invention is inoperative. In support of that conclusion, the Office Action states:

[A]ssembly of an object from impulses of energy, subatomic particles, and impulses of energy which are inputted and supplied to a transmission means is simply not physically possible in the manner described. It is that of science fiction which relates to replication from energy alone.

Office Action at p. 4. Applicant respectfully disagrees.

As described in the articles listed in the Information Disclosure Statement (IDS) submitted herewith, methods and devices for disassembling an object and reassembling it in another location based on information transmitted through a transmission device were practiced as early as 2004.

For example, physicists at the Institute for Experimental Physics in Vienna used a first laser at a first location to generate a first photon and used a fiber-optic cable and microwaves to teleport three different states of the first photon to a second photon generated with a second laser at a second location. *See, e.g.*, Graham, Sarah, “Quantum Teleportation Across the Danube Demonstrated”, SCIENTIFIC AMERICA, August 19, 2004 (hereinafter “the Graham article”). And, two separate groups of physicists were able to transfer key properties of atoms (e.g., energy, motion, magnetic field and other physical properties) from one calcium atom to another without a physical link. *See, e.g.*, Rincon, Paul, “Teleportation Breakthrough Made”, BBC NEWS, June 16, 2004. Both of those methods of quantum teleportation utilize a phenomenon known as “entanglement”, in which atoms enter a quantum state where, based on the rules of quantum physics, a first atom will adopt the properties of a second atom and the second atom will thereby lose those properties. Accordingly, the assembly of an object (e.g., a photon or an atom) from impulses of energy and subatomic particles (e.g., microwaves and/or fiber-optic signals) inputted into a transmission means (e.g., a fiber-optic cable) is physically possible in the claimed manner.

Because the assembly of an object from impulses of energy and subatomic particles inputted into a transmission means is physically possible in the claimed manner, Applicant respectfully submits that the claimed invention is not inoperable and has novelty. Moreover, as set forth at MPEP § 2107.01(II) at 2100-24, “[a] commercially successful product is not required ... Nor is it essential that the invention accomplish all its intended functions ... or operate under all conditions .. partial success being sufficient to demonstrate patentable utility.” Applicant respectfully submit that the claimed invention satisfies those requirements. Applicant therefore respectfully requests

reconsideration and withdrawal of the rejection of Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 101.

**B. Rejection of Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75
Under 35 U.S.C. § 112, First Paragraph**

The Office Action rejects Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In more detail, the Examiner rejects those claims for not being enabled by the Specification. Relying largely on the assertions made in the rejection under 35 U.S.C. § 101, the Office Action states:

[T]he assembly system proposed by applicant simply is not capable of functioning in the manner described. One cannot make an object of matter from subatomic or atomic particles and/or impulses of energy which are inputted and transmitted from one local to another to make matter.

Office Action at p. 5. As discussed above, however, the physical properties of a photon and atom have been transmitted from one local to another. Although those examples are not expressly recited in the Specification, the articles listed in the IDS submitted herewith and cited above set forth what was known in the art at the time of the claimed invention. Moreover, as explained in the Amendment filed in the present application on April 1, 2010, the theories required to perform the claimed functions were also known in the art at the time of the claimed invention.

As explained in MPEP § 2163(II)(A)(2), at 2100-178, “[i]nformation which is well known in the art need not be described in detail in the specification.” (citing *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80 (Fed. Cir. 1986)). As the articles cited above establish, specific manners of disassembling, transmitting, and reassembling atomic and subatomic particles (e.g., a laser fired through a barium borate crystal, a fiber-optic cable, and microwaves, as described

in the Graham article) were well known in the art at the time of the claimed invention. In addition to the devices described in the articles cited above, other manners of assembling matter based on information in signals and impulses of energy were also well known in the art at the time of the claimed invention. *See, e.g.*, U.S. Patent No. 7,261,542 to *Hickerson et al.* (describing a device for assembling 3-dimensional objects based on information in a signal sent to the device). Accordingly, neither the devices nor the theories on which they operate need to be described in detail in the Specification.

Because the disclosure of the present invention would bring to mind for the person having ordinary skill in the art specific examples of the theories and devices that could be used in making and using the invention as claimed, Applicant respectfully submits that those devices are described in a meaningful manner and, thereby, enable the invention as claimed. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of Claims 34-75 under 35 U.S.C. § 112, first paragraph.

C. Rejection of Claims 70 and 72-75 Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects Claims 70 and 72-75 under 35 U.S.C. § 112, second paragraph, as being indefinite. In more detail, the Office Action rejects Claims 70 and 72-75 because Claim 70 recites “[a] method for selling an object” while the body of that claim is solely limited to a method of making the object. But by the present amendment, Claim 70 is amended to recite various features regarding the sale of the object (e.g., “selling an object”, “seller’s location”, “when the object is being sold”, and “buyer’s location”). Accordingly, Applicant respectfully submits that

Claims 70 and 72-75 no longer indefinite. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of Claims 70 and 72-75 under 35 U.S.C. § 112, second paragraph.

D. Rejection of Claims 34, 36, 37, 39-45, 47-57, 60-70, and 72-75
Under 35 U.S.C. § 102(b)

The Office Action rejects Claims 34, 37-40, 43, 44, 47-67, 70, 72, and 73 under 35 U.S.C. § 102(b) as anticipated by the Sternbach reference. As amended, independent Claims 34 and 70 now recite “a system for selling an object” that utilizes “at least one disassembling means ... adapted to record the information about and disassemble the object.” That feature was previously recited in now-cancelled dependent Claims 35 and 71. Nowhere does the Sternbach reference disclose such a feature. Moreover, nowhere does the Sternbach reference describe using a disassembling means as part of a system for selling an object. As claimed, for example, a buyer desiring an object with certain properties (e.g., a calcium atom with specific physical properties) can purchase such an object from a seller in possession of an object with those properties.

Because the Sternbach reference fails to disclose each and every feature recited in independent Claims 34 and 70 – namely, using a disassembling means in a system for selling an object – Applicant respectfully submits that the Sternbach reference does not anticipate those claims. Likewise, by virtue of their dependency on independent Claims 34 and 70, Applicant respectfully submits that corresponding dependent Claims 37-40, 43, 44, 47-67, 72, and 73 also are not anticipated by the Sternbach reference. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of 34, 37-40, 43, 44, 47-67, 70, 72, and 73 under 35 U.S.C. § 102(b).

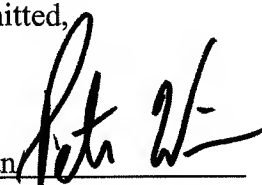
V. CONCLUSION

In view of the foregoing discussion and amendments, Applicant respectfully submits that the present Application is in condition for allowance. Early and favorable action is therefore respectfully requested.

In the event there are any questions relating to this Amendment or to the present Application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of the present Application may further be expedited.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (130451.0103). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fees due are authorized above.

Respectfully submitted,



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